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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,657	04/15/2004	Sung-hee Hwang	1293.1864	7724

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EXAMINER
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HUBER, PAUL W

ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,657	<b>Applicant(s)</b> HWANG ET AL.	
	<b>Examiner</b> Paul Huber	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-21, 29, 36-39 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-21, 29, 36-39 and 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims 9-16, 18-20, 29, 36-39 and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 and 19-25 of copending Application No. 11/226,224. Although the conflicting claims are not identical, they are not patentably distinct from each other because: as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] a patentable distinction does not lie where a later claim is anticipated by an earlier one" (see also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim); and/or it would have been obvious to one having ordinary skill in the art to have the apparatus/drive claims for recording/reproducing data, the motivation being to record/reproduce the optical data storage medium of the copending claims with an apparatus/drive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 9-21, 29, 36-39 and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/432,328. Although the conflicting claims are not identical, they are not patentably distinct from each other because: as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] a patentable distinction does not lie where a later claim is anticipated by an earlier one" (see also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 9-16, 18-20, 29, 36-39 and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 11/432,470. Although the conflicting claims are not identical, they are not patentably distinct from each other because: as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] a patentable distinction does not lie where a later claim is anticipated by an earlier one" (see also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is

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anticipated by, and therefore not patentably distinct from, an earlier species claim); and/or it would have been obvious to one having ordinary skill in the art to have the apparatus/drive claims for recording/reproducing data, the motivation being to record/reproduce the optical data storage medium of the copending claims with an apparatus/drive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).


A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited on the PTO-892 each disclose a recording/reproducing apparatus and method for recording/reproducing defect management information on a recording medium.

Claims 9-21, 29, 36-39 and 42-49 would be allowed if a terminal disclaimer is timely filed as explained above.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.

  
Paul Huber  
Primary Examiner  
Art Unit 2627

pwh  
October 2, 2006